

Atty Dkt. No.: 10050560-1  
USSN: 10/032,281

### REMARKS

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Claims 1-6, 8, 15-17, 87-88 and 90-92 are pending.

The Applicants respectfully request reconsideration of this application.

#### Rejection of claims under 35 U.S.C. § 103 – Strutt in view of Schena

Claims 1-6, 8, 15-17, 87, 88 and 90-92 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Strutt (EMBO J. 1997 16: 3621-3631) in view of Schena (Tibtech (1998) 16:301-306). The Applicants respectfully traverse this rejection.

It is well established that in order to establish a *prima facie* case of obviousness, all claim elements must be taught or suggested in a prior art reference, or a combination of prior art references.

The rejected claims require a step in which an immunoprecipitated DNA fragment is blunted prior to adaptor ligation. See, e.g., element e) of claim 1:

"i. blunting said DNA fragment to produce blunt ends"

This blunting step is neither taught nor suggested by Strutt. Rather, according to the last four lines of col. 1 of page 3622<sup>1</sup> and the last paragraph of col. 2 of page 3630<sup>2</sup> of Strutt's disclosure, Strutt's method is one in which the adaptors are ligated *directly* to the immunoprecipitated DNA fragments. At no point does Strutt mention blunting the immunoprecipitated DNA fragments prior to adaptor ligation, as required by the rejected claims. Thus, Strutt is deficient in that it does not teach or suggest an element of the rejected claims.

Shena fails to meet Strutt's deficiency, and, as such, this rejection should be withdrawn.

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<sup>1</sup> "In this report, blunt-end linkers are ligated directly to the immunoprecipitated DNA fragments" Strutt, page 3622, col. 1, last four lines. Emphasis added by Applicants.

<sup>2</sup> "Cross-linking ..... and immunoprecipitation from cross-linked chromatin were carried out exactly as previously described (Orlando and Paro, 1993; Orlando *et al*, 1997), except for a modification in the PCR amplification protocol, in which a blunt-ended linker was ligated directly to the sonicated, immunoprecipitated DNA." Strutt, page 3630, last paragraph of col. 2. Emphasis added.

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Further, since Strutt's amplification method is different to the one recited in the rejected claims, the Applicants submit that the Examiner's main lines of reasoning for giving no weight to the Wyrick Declaration, namely that the claim-recited labeling method is the "precise labeling method performed by Strutt" and "Strutt performed the method prior to Dr. Wyrick and obtained the same result which Dr. Strutt had expected", are unsupported. Thus, Dr. Wyrick's declaration carries full weight, and should not be ignored.

A Notice of Allowance is respectfully requested.

### CONCLUSION

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone James Keddie at (650) 833 7723.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10050560-1.

Respectfully submitted,  
BOZICEVIC, FIELD & FRANCIS LLP

Date: August 2, 2007

By: 

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